

### REMARKS

Claims 20-36 are pending in the above-identified patent application. Claim 36 has been amended and new Claims 37-41 have been added for consideration by the Examiner. Applicants respectfully request entry of this Amendment, and reconsideration and allowance of this application.

Applicants believe that the Amendment overcomes the rejections under 35 U.S.C. 112, second paragraph. Applicants request withdrawal of this rejection.

The rejection of Claims 20-29 and 33-35 under 35 U.S.C. 103(a) as being unpatentable over Fahy (U.S.P.N. 5,488,984) in view of Parkinson (U.S.P.N. 3,839,256), is respectfully traversed.

Fahy discloses a process for treating metal components, which are die punched from a sheet, that are used in manufacturing an electric motor. Fahy seeks to eliminate atmospheric heat treatments (e.g., ref to Col. 1, Lines 58-60 and Col. 2, Lines 19-21 of Fahy).

Parkinson discloses a coating for use in manufacturing steel sheets (not for manufacturing the die punched components employed by Fahy). It is important to note that Parkinson is not in the same field of endeavor as Fahy (i.e., Parkinson is not treating shaped electric motor components/laminates but rather Parkinson is treating lengths of sheet stock that have not been fabricated into any defined configuration). The coating employed by Parkinson requires a heat treatment in order to cure the coating (e.g., refer to the Abstract, Col. 4, Lines 21-25 of Parkinson). Assuming arguendo that Fahy and Parkinson were treating similar parts (i.e., die punched parts v. sheet stock), a skilled person in this art would not consider the processes of Fahy and Parkinson as being analogous due to the conflicting teachings on heat treatments. Therefore, Applicants respectfully submit that a skilled person in this art would lack the requisite motivation to combined Fahy and Parkinson.

Moreover, neither Fahy nor Parkinson identify any problem with the insulation or handling characteristics of Fahy's components. Applicants respectfully submit that, in the absence of Applicants' disclosure, a skilled person in this art would not combine Fahy

and Parkinson since there is no identified problem associated with Fahy or Parkinson that is solved by the combination. For these reasons, Applicants respectfully submit that a skilled person in this art would not combine Fahy and Parkinson and, assuming *arguendo* that these references could be combined, the combination fails to teach the claimed invention.

The rejection of Claims 20-27, 29 and 31-32 under 35 U.S.C. 103(a) as being unpatentable over Fahy (U.S.P.N. 5,488,984) in view of Heimann (U.S.P.N. 5,714,093), is respectfully traversed.

Fahy contains the aforementioned deficiencies. These deficiencies are not remedied by Heimann. Heimann relates to gels, greases and coating for improving the corrosion resistance of metals. It is important to note that Fahy and Heimann are not in the same field of endeavor. That is, Fahy does not disclose, teach or suggest that gels, lubricants or greases are useful for treating electric motor laminates and Heimann does not suggest that his gels, lubricants and greases are useful in withstanding the molten metal encapsulation employed by Fahy. Further, Fahy lacks any disclosure indicating that corrosion is a problem. Further still, neither Fahy or Heimann provide any basis for equating or substituting corrosion resistance for resistance to molten metal or preventing adhesion/solder between steel and aluminum. Applicants, therefore, respectfully submit the requisite motivation to combine these references, which is not based upon Applicants' disclosure, has not been established. Improperly combined references cannot be employed to establish a *prima facie* case of obviousness and, accordingly, Applicants respectfully request withdrawal of this rejection.

The rejection of Claim 30 under 35 U.S.C. 103(a) as being unpatentable over Fahy and Parkinson or Heimann and further in view of Takimoto et al. (U.S.P.N. 5,298,059), is respectfully traversed.

Fahy, Parkinson and Heimann each contain the aforementioned deficiencies. Takimoto clearly teaches away from silica or a silica containing composition (e.g., see Abstract Takimoto). Further, Takimoto is limited to anticorrosive coatings and lacks any disclosure relating to protecting surfaces from molten metal or electric motors (e.g., rust-

proofed steel for use in electrical appliances is not equivalent to usage in an electrical motor.). Takimoto, therefore, fails to remedy the deficiencies of the primary references and, accordingly, Applicants respectfully request withdrawal of this rejection.

The rejection of Claims 31 and 36 under 35 U.S.C. 103(a) as being unpatentable over Fahy and Parkinson and further in view of Ettinger et al. (U.S.P.N. 4,479,104), is respectfully traversed.

Ettinger fails to remedy the aforementioned deficiencies of Fahy and Parkinson. Ettinger relates to transformer cores having an electrically insulating semi-conducting layer between laminations. The purpose of these electrically insulating layers is not identified as being useful as a molten metal protectant or that an electrical motor is improved by providing any degree of conductivity at an impulse voltage. For these reasons, Ettinger is not properly combined with the primary references and cannot establish a prima facie case of obviousness.

The rejection of Claims 20-25, 27, 33 and 35 under 35 U.S.C. 103(a) as being unpatentable over Fahy (U.S.P.N. 5,488,984) in view of JP4165082 and van Ooij et al. (U.S.P.N. 5,108,793), is respectfully traversed.

Fahy contains the aforementioned deficiencies. Similar to Parkinson discussed above, JP '082 relates to sheet stock (not die punched components) and employs a heat treatment avoided by Fahy. Therefore, Fahy and JP '082 are directed to processing non-analogous components and contain conflicting processes (e.g., with respect to heat treating).

These deficiencies and conflicts are not remedied by van Ooij et al. van Ooij also relates to treating sheet stock and not to the die punched electrical motor components of Fahy. Therefore, a skilled person in this art would lack the requisite motivation to combine Fahy, JP '082 and van Ooij.

The rejection of Claim 26 under 35 U.S.C. 103(a) as being unpatentable over Fahy, JP '082, van Ooij et al., and Miyosawa (U.S.P.N. 4,016,129), is respectfully traversed.

Fahy, JP '082 and van Ooij et al. contain the aforementioned deficiencies and conflicting teachings. These deficiencies are not remedied by Miyosawa. Miyosawa's coating does not contain silica because silica is a precursor that is converted or reacted with a polyvinyl alcohol. Therefore, assuming arguendo that Fahy, JP '082, van Ooij and Miyosawa are combinable, the combination fails to establish a prima facie case of obviousness.

The rejection of Claims 30 and 36 under 35 U.S.C. 103(a) as being unpatentable over Fahy, JP '082, van Ooij et al. and Takimoto et al. (U.S.P.N. 5,298,059), is respectfully traversed.

Fahy, JP '082 and van Ooij et al. contain the afore-mentioned deficiencies. Takimoto fails to remedy these deficiencies. Takimoto clearly teaches away from silica or a silica containing composition (e.g., see Abstract Takimoto). Further, Takimoto is limited to anticorrosive coatings and lacks any disclosure relating to protecting surfaces from molten metal or electric motors (e.g., rust-proofed steel for use in electrical appliances is not equivalent to usage in an electrical motor.). Takimoto, therefore, fails to remedy the deficiencies of the primary references and, accordingly, Applicants respectfully request withdrawal of this rejection.

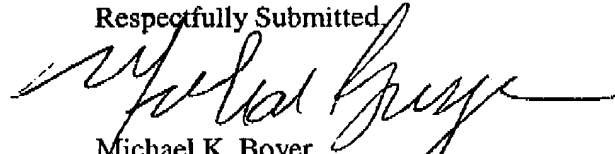
The rejection of Claim 31 under 35 U.S.C. 103(a) as being unpatentable over Fahy, JP '802, van Ooij et al and Ettinger et al. (U.S.P.N. 4,479,104), is respectfully traversed.

Fahy, JP '802 and van Ooij et al. contain the aforementioned deficiencies. These deficiencies are not remedied by Ettinger. Ettinger relates to transformer cores having an electrically insulating semi-conducting layer between laminations. The purpose of these electrically insulating layers is not identified as being useful as a molten metal protectant or that an electrical motor is improved by providing any degree of conductivity at an impulse voltage. For these reasons, Ettinger is not properly combined with the primary references and cannot establish a prima facie case of obviousness.

In instant application claims benefit of U.S. Patent Application Serial No. 09/549,119 (now U.S. Patent No. 6,455,100). Applicants respectfully request consideration of this patent as well as the references cited therein on the previously submitted Supplemental Information Disclosure Statement.

Applicants believe that the pending claims define patentable subject matter and respectfully request issuance of a Notice of Allowability for the instant application. Please find attached hereto a Request For Continued Examination Transmittal. Please also find attached hereto a Petition for a Three Month Extension of Time. Should there any other fee due in connection with the instant application, please charge the same to Deposit Account No. 15-0680 (Orscheln Management Co.). Should the Examiner deem that any further action on the part of Applicants would advance prosecution of this application, the Examiner is invited to telephone Applicants' attorney.

Respectfully Submitted



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